

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPEAL BRIEF

Inventor(s)	:	Terry L. Oehrke
Serial No.	:	09/594,070
Filing Date	:	June 14, 2000
Title	:	COMPUTER NETWORK METHOD AND SYSTEM FOR GUARANTEED MESSAGING SERVICE
Group/Art Unit	:	2144
Examiner	:	Scott B. Christensen
Docket No.	:	1234

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In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits this Appeal Brief in support of the Notice of Appeal filed March 28, 2008 and in response to the Final Office Action mailed on December 31, 2007. Please charge the \$510.00 fee for filing this Appeal Brief to our Deposit Account No. 19-4409.

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I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is the assignee, Sprint Communications Company, L.P. The assignment was recorded at Reel 011258, Frame 0478 of the U.S. Patent and Trademark Office records.

II. RELATED APPEALS AND INTERFERENCES

This application was previously appealed to the Board of Patent Appeals and Interferences in Appeal No. 2007-1044. A copy of the decision entered in Appeal No. 2007-1044 is enclosed herewith in the Related Proceedings Appendix. There are no other related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1, 3-5, 7-9, 11-13, and 15-19 are pending in this application. Claims 1, 3-5, and 7-8 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,974,122 to Nelson et al. Claims 9, 11-13, and 15-19 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,974,122 to Nelson et al. in view of "DNS (domain name system)" allegedly posted on "whatis.com" on February 29, 2000, and downloaded by the Examiner from: "<http://web.archive.org/web/20000307002913/-whatis.com/dns.htm>". Claims 1, 3-5, 7-9, 11-13, and 15-16 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,821 to Ozzie et al. Claims 17-19 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,859,821 to Ozzie et al. Claims 1, 3-5, 7-9, 11-13, and 15-19 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0036822

to Mead et al. Claim 18 stands finally rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The present Appeal is directed to the rejection of claims 1, 3-5, 7-9, 11-13, and 15-19, which are reproduced in the claims appendix attached hereto.

IV. STATUS OF AMENDMENTS

An Amendment After Final with an amendment to claim 18 was filed concurrently with the Notice of Appeal on March 28, 2008. Claim 18 was amended to present rejected claim 18 in better form for consideration on appeal pursuant to 37 C.F.R. § 1.116(b)(2). In the Office Action mailed on December 31, 2007, the Examiner rejected Claim 18 under 35 U.S.C. § 112, second paragraph, as being indefinite because it was dependent from claim 10, which had been previously cancelled. Claim 18 as amended now properly depends from claim 9, which is still pending. In an Advisory Action dated April 25, 2008, this claim amendment was entered by the Examiner for purposes of appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a method for providing a messaging service on a computer network 10 and will be described with reference to Figs. 1 and 2 of the application. The method comprises the steps of: (a) routing a message to a messaging server 14 (Fig. 2, step 24; page 6, lines 12-23); (b) providing the message to a relay server 16 when the messaging server 14 is inoperable such that the message is undeliverable to the messaging server 14 (Fig. 2, step 30; page 6, line 24 to page 7, line 4); (c) re-routing the message from the relay server 16 to

the messaging server 14 if the messaging server 14 becomes operational (Fig. 2, step 32; page 7, lines 5-25); and (d) invoking another messaging server 18 if the messaging server 14 does not become operational (Fig. 2, step 38; page 7, line 26 to page 8, line 10).

Independent claim 9 is directed to a computer network 10 for providing a messaging service and will be described with reference to Fig. 1 of the application. The computer network comprises: a messaging server 14 (page 4, lines 6-7); a DNS server 12 operable to route a message to the messaging server 14 (page 4, lines 19-30); a relay server 16 operably connected to the DNS server 12 and the messaging server 14 (page 5, lines 10-13), the DNS server 12 operable to provide the message to the relay server 16 when the messaging server 14 is inoperable such that the message is undeliverable to the messaging server 14 (page 4, lines 7-8; page 5, lines 10-11); wherein the relay server 16 is operable to re-route the message from the relay server 16 to the messaging server 14 if the messaging server 14 becomes operational (page 5, 11-13); and another messaging server 18, the other messaging server 18 invoked by the relay server 16 if the messaging server 14 does not become operable such that the message is undeliverable to the messaging server 14 in response to the re-routing (page 5, line 25 to page 6, line 11).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

1. Whether claims 1, 3-5, and 7-8 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,974,122 to Nelson et al.;
2. Whether claims 9, 11-13, and 15-19 are unpatentable under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,974,122 to Nelson et al. in view of "DNS

(domain name system)" allegedly posted on "whatis.com" on February 29, 2000, and downloaded by the Examiner from <http://web.archive.org/web/20000307002913/whatis.com/dns.htm>;

3. Whether claims 1, 3-5, 7-9, 11-13, and 15-16 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,821 to Ozzie et al.;

4. Whether claims 17-19 are unpatentable under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,859,821 to Ozzie et al.;

5. Whether claims 1, 3-5, 7-9, 11-13, and 15-19 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0036822 to Mead et al.; and

6. Whether claim 18 is unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

VII. ARGUMENT

1. Claims 1, 3-5, and 7-8 are not anticipated by Nelson.

The Examiner rejected claims 1, 3-5, and 7-8 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,974,122 to Nelson et al. ("*Nelson*"). This rejection is astounding because the Board of Patent Appeals and Interferences, in its July 31, 2007 decision in Appeal No. 2007-1044, enclosed herewith in the Related Proceedings Appendix, has already reversed a rejection of these claims under 35 U.S.C. § 103(a) over *Nelson* in combination with other references.

Claim 1 is directed to a method for providing a messaging service on a **computer network**, comprising: (a) routing a message to a messaging server; (b) providing the message to a relay server when the messaging server is inoperable; (c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational; and (d) **invoking another messaging server** if the messaging server in step (c) does not become operational.

Nelson discloses a system and method for delivery of a facsimile to an intended destination when that destination is initially unavailable. In the system of *Nelson*, a facsimile message transmission is first attempted by initiating a telephone call from a first fax machine to an intended destination second fax machine (Col. 2, Lines 20-23). If the second fax machine is available and answers the telephone call, the facsimile message is transmitted to the second fax machine (Col. 2, Lines 23-30). However, if the second fax machine is not available (*i.e.*, busy or no answer), the facsimile message is routed to, and stored on, a messaging platform (Col. 2, Lines 30-33). The messaging platform, according to a predetermined schedule, makes subsequent calls to the second fax machine (Col. 2, Lines 33-41). If the second fax machine answers, the facsimile message is delivered from the messaging system to the second fax machine (Col. 2, Lines 36-38). If the second fax machine is busy or does not answer, the messaging platform stores the message and re-attempts delivery at a later time according to the predetermined schedule (Col. 2, Lines 38-41). If transmission of the facsimile message to the second fax machine is still unsuccessful after several re-attempts, a message is sent back to the originator of the facsimile message, informing them that delivery could not be accomplished (Col. 2, Lines 51-63).

Nelson does not disclose: (1) A method for providing a messaging service on a **computer network** . . . comprising . . . routing a message to a **messaging server**; or (2) invoking

another messaging server if the messaging server in step (c) does not become operational. Regarding limitation (1), as discussed above *Nelson* discloses a method for delivering facsimile messages over telephone lines, not a method for providing a messaging service on a **computer network**. The examiner states that the fax machines of *Nelson* are equivalent to the messaging server of claim 1, and that fax machines are types of computers (Office Action, Dec. 31, 2007, p. 24). However, fax machines, which transmit messages over telephone lines, are clearly not the same as messaging servers which transmit messages over a computer network. The specification of the present application states that the invention relates to reliable messaging within a computer network, whether the network is a local area network or a wide area network (page 2, lines 12-15). *Nelson* does not have an enabling disclosure of a fax machine sending messages over a computer network such as the local area network or wide area network disclosed in the specification of the present application. Thus, *Nelson* does not disclose a computer network having a messaging server as required by claim 1.

The examiner argues that *Nelson* discloses the Internet may be used to transmit the facsimile messages (Office Action, Dec. 31, 2007, p. 24). The only statement in *Nelson* regarding the Internet is the following: "In particular, facsimile messages and voice messages, within the scope of the present invention, [sic] be transmitted using data communications networks such as the internet." (Col. 10, Lines 20-23). Section 2121.01 of the MPEP states: "The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation." The above cited statement in *Nelson* does not enable a person of ordinary skill in the art to transmit facsimile messages over the Internet without undue experimentation. Therefore, *Nelson* does not anticipate claim 1.

Nelson also does not disclose limitation (2) above, namely, invoking **another messaging server** if the messaging server in step (c) does not become operational. As discussed above, *Nelson* discloses a system and method for delivery of a facsimile to an intended destination by storing and repeatedly re-attempting transmission of the facsimile to the destination. In *Nelson*, however, if a destination is busy or does not answer, an Analyze Route Message is returned to the originating number, indicating that the intended destination was not available (*see* Col. 5, Lines 30-41). Thus, *Nelson* does not disclose invoking another messaging server to allow delivery of the message when the original messaging server does not become operational. Regarding claim 1, the examiner states "the claim does not disclose what invokes the messaging server, or even the time that the messaging server is invoked" (Office Action, Dec. 31, 2007, p. 24). The examiner's statement is incorrect, but even if it was correct, it does not lead to the conclusion that *Nelson* discloses "invoking another messaging server." Claim 1 is directed to a method for providing a messaging service on a computer network. Clearly, it is some element of the claimed computer network that performs the claimed steps including "invoking another messaging server." Also, the claim does state when the other messaging server is invoked, the claim states that the other messaging server is invoked "if the messaging server in step (c) does not become operational."

The Examiner states that Fax Messaging Platform 134, shown in Fig. 2 of *Nelson*, "is interpreted as being another messaging server, as it provides the message to other devices or programs" (Office Action, Dec. 31, 2007, p. 3). The Examiner also maintains that Fax Messaging Platform 134 operates as the claimed "relay server" (*Id.* at 3, 25). Clearly, Fax Messaging Platform 134 cannot serve as both the "relay server" and the "another messaging server" of claim 1. *Nelson* does not disclose Fax Messaging Platform 134 acting as the "relay

server" and delivering a message to itself as the "another messaging server" if the original fax recipient does not become operational. It does not make sense for the Fax Messaging Platform 134 to deliver a message to itself. If the facsimile transmission of *Nelson* is undeliverable to its intended recipient, then the facsimile is not transmitted and the sender is notified via the Analyze Route Message described above (Col. 5, Lines 30-41). In an attempt to support his argument, the examiner states that "claim 1 does not require that the message is ever sent to the other messaging server" (Office Action, Dec. 31, 2007, p. 25). The examiner is wrong because claim 1 clearly requires "invoking another messaging server if the messaging server in step (c) does not become operational." Even if claim 1 did not require this step, it still would not support the Examiner's position that *Nelson* anticipates claim 1 because the Fax Messaging Platform 134 of *Nelson* cannot be both the "relay server" and "another messaging server" of claim 1.

For the reasons above, Applicant requests that the Board reverse the rejection of claim 1 as anticipated by *Nelson*. Applicant also requests that the Board reverse the rejection of claims 3-5 and 7-8, which are dependent upon claim 1, because claim 1 is allowable.

2. Claims 9, 11-13, and 15-19 are not obvious over Nelson in view of "DNS (domain name system)."

The Examiner rejected claims 9, 11-13, and 15-19 under 35 U.S.C. § 103(a) as being unpatentable over *Nelson* in view of "DNS (domain name system)" allegedly posted on the Internet February 29, 2000 on [whatis.com](http://web.archive.org/web/20000307002913/whatis.com/dns.htm) and downloaded from <http://web.archive.org/web/20000307002913/whatis.com/dns.htm>.

Claim 9 requires, *inter alia*:

A **computer network** for providing a messaging service
comprising:
a messaging server;

a DNS server operable to route a message to the messaging server;
a relay server operably connected to the DNS server and the messaging server, the DNS server operable to provide the message to the relay server when the messaging server is inoperable . . . ;

wherein the relay server is operable to re-route the message from the relay server to the messaging server if the messaging server becomes operational; and

another messaging server, the other messaging server invoked
by the relay server if the messaging server does not become operable

First, Applicant disputes that the "DNS (domain name system)" reference was available as of February 29, 2000. The Examiner cites an Internet website named the "Wayback Machine" as evidence that the reference was available on February 29, 2000. (Office Action, Dec. 31, 2007, p. 15). However, the actual website the Examiner seeks to use as a reference lists a publication date of February 16, 2004 (Exhibit A in the Evidence Appendix following this brief, Whatis.com, What is domain name system? – a definition from Whatis.com, http://searchnetworking.techtarget.com/sDefinition/0,,sid7_gci213908,00.html (last visited Apr. 25, 2008)). The Examiner argues that the difference in dates may be due to the fact that now there is a hyperlink associated with the word "access provider" and on the "Wayback Machine" there was no hyperlink. (Office Action, Dec. 31, 2007, p. 26). Under MPEP § 2128, the Examiner has the burden to prove the date an electronic publication was published. Here, the Examiner has not met this burden because it is unclear why the actual website displays a different publication date than the date on the "Wayback Machine." Applicant maintains that the "Wayback Machine" is not a reliable source of information, as evidenced by the different publication dates, and thus the Examiner's reliance on the "Wayback Machine" as evidence that this reference was available on February 29, 2000 was incorrect. Therefore, Applicant submits that the Board should reverse the examiner's rejection of claims 9, 11-13 and 15-19 based on this reference.

Assuming *arguendo* that the Examiner's citation to the "Wayback Machine" was proper, the Board should reverse the Examiner's rejection of claims 9, 11-13 and 15-19 based on *Nelson* and DNS (domain name system) for the reasons presented below.

As discussed above with respect to Claim 1, *Nelson* does not disclose (1) a **computer network** for providing a **messaging service**; or (2) **another messaging server** which is invoked by the relay server if the first messaging server does not become operable. Regarding limitation (1), *Nelson* instead discloses a facsimile transmission system which is different from a computer network for providing a messaging service. Regarding limitation (2), if the fax recipient in *Nelson* is inoperable, the system sends an Analyze Route Message back to the originating fax machine (Col. 5, Lines 30-41). There is no disclosure of another fax machine which is invoked by the fax messaging platform. Further, the reference DNS (domain name server) does not disclose these limitations. For these reasons and any of the reasons discussed above with respect to claim 1, Applicant requests that the Board reverse the Examiner's rejection of claim 9 under 35 U.S.C. § 103(a) over *Nelson* in view of DNS (domain name system). Applicant also requests that the Board reverse the Examiner's rejection of claims 11-13 and 15-19, which are dependent from claim 9, because claim 9 is allowable.

3. Claims 1, 3-5, 7-9, 11-13, and 15-16 are not anticipated by Ozzie.

The Examiner rejected claims 1, 3-5, 7-9, 11-13, and 15-16 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,859,821 to Ozzie et al. ("*Ozzie*").

a. Claims 1, 3-5, and 7-8

Ozzie does not anticipate claim 1 because *Ozzie* does not disclose the step of "invoking another messaging server." *Ozzie* discloses a method and apparatus for prioritizing data change requests and maintaining data consistency in a computer network. In the system of

Ozzie, as shown in Fig. 8, a plurality of peer units are equipped for communication via the Internet (Col. 15, Lines 65-67). Each peer unit has a communications manager that is connected to the Internet and controls communication between peer units (Col. 16, Lines 5-29). The Internet has a presence server which detects whether peer units are on-line or off-line and a relay with the capability to store messages destined for off-line peer units (Col. 16, Lines 29-34). If a peer unit sends a message to another peer unit and the other peer unit is on-line, then the message is delivered directly to the other peer unit (Col. 16, Lines 35-42). If the destination peer unit is off-line when the message is sent, then the message is delivered to the relay which stores the message until the destination peer unit returns on-line (Col. 16, Lines 43-54). However, if the destination peer unit does not return on-line, then the message is not delivered (Col. 16, Lines 43-54).

Ozzie does not disclose "invoking **another messaging server** if the messaging server in step (c) does not become operational" as required by claim 1. As discussed above, *Ozzie* discloses a network of peer units which communicate via the internet (Col. 15, Lines 65-67). If a peer unit sends a message and the destination peer unit is not available for receiving a message, then the message is sent to a relay (Col. 16, Lines 43-54). The relay stores the message and delivers it to the destination peer unit when it becomes available (*Id.*). If the destination peer unit does not become available, then the message is not delivered (*Id.*). Thus, *Ozzie* does not disclose invoking another messaging server if the destination messaging server does not become operational.

The Examiner maintains that Fig. 8 and Column 16, Lines 35-54 of *Ozzie* disclose the step of "invoking another messaging server" (Office Action, Dec. 31, 2007, p. 6). As discussed above, there is absolutely no disclosure in *Ozzie* of invoking another peer unit if the

destination peer unit is not available to receive a message. Thus, *Ozzie* does not disclose all of the limitations of claim 1.

For the reasons above, Applicant requests that the Board reverse the Examiner's rejection of claim 1 as anticipated by *Ozzie*. Applicant also requests that the Board reverse the Examiner's rejection of claims 3-5 and 7-8, which are dependent from claim 1, because claim 1 is allowable.

b. Claims 9, 11-13, and 15-16

As discussed above with respect to claim 1, *Ozzie* does not disclose "**another messaging server**, the other messaging server invoked by the relay server if the messaging server does not become operable". A message stored in the relay of *Ozzie* is not delivered if the destination peer unit does not become operable (Col. 16, Lines 43-54). For this reason and the reasons discussed above with respect to claim 1, Applicant requests that the Board reverse the Examiner's rejection of claim 9 as anticipated by *Ozzie*. Applicant also requests that the Board reverse the rejection of claims 11-13 and 15-16, which are dependent from claim 9, because claim 9 is allowable.

4. Claims 17-19 are not obvious over *Ozzie*.

Applicant requests that the Board reverse the rejection of claims 17-19 as obvious in view of *Ozzie* because claims 17-19 are dependent from claim 9, and claim 9 is allowable for the reasons discussed above. Namely, because *Ozzie* does not disclose "another messaging server."

5. Claims 1, 3-5, 7-9, 11-13, and 15-19 are not anticipated by Mead.

The Examiner rejected claims 1, 3-5, 7-9, 11-13, and 15-19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0036822 to Mead et al. ("*Mead*").

a. Claims 1, 3-5, and 7-8

Mead does not anticipate claim 1 because *Mead* does not disclose steps (b), (c), or (d) of claim 1. *Mead* discloses a system for delivering electronic mail between users in a vehicle and users outside a vehicle (Para. [0005]). In the system of *Mead*, a message can be sent from a home mail server 102 to a vehicle server 110 via an intermediate ground server 106 (Fig. 1; Para. [0015]). The ground server 106 communicates with the home mail server 102 via a network 104 (e.g. the Internet), and the ground server 106 communicates with the vehicle server 110 via a data link 108 (Para. [0015]). The vehicle server 110 is located on a vehicle and allows users on the vehicle to send messages through their home mail server 102 and receive messages from their home mail server (Para. [0015]). The vehicle server 110 and ground server 106 are not necessarily in constant communication, but instead decide when to connect based on factors such as the amount of data to be transmitted, the urgency of the data, geographic location and data type (Para. [0015]).

Mead does not disclose the following limitations of claim 1 "(b) providing the message to a relay server when the messaging server is inoperable . . . ; (c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational; and (d) invoking another messaging server if the messaging server in step (c) does not become operational".

As discussed above, *Mead* discloses sending a message from a home mail server to a vehicle server via an intermediate ground server. *Mead* does not disclose any of the servers

becoming inoperable and *Mead* does not disclose where a message would be sent if any of the servers became inoperable. Therefore, *Mead* does not disclose providing a message to a relay server when the messaging server is inoperable, re-routing the message from the relay server to the messaging server if the messaging server becomes operational, and invoking another messaging server if the messaging server in step (c) becomes operational.

The Examiner states step (b) only needs to be performed when the message is undeliverable and that there is no requirement that the message be undeliverable. Claim 1 requires "invoking another messaging server if the messaging server in step (c) does not become operational". This limitation is a requirement that must occur if the message is undeliverable and *Mead* does not disclose this limitation.

The Examiner states that step (c) is only performed if step (b) occurred because the relay server only has the message if the message was undeliverable to the messaging server. The Examiner is correct that step (c) is only performed if step (b) occurred. However, *Mead* still does not disclose step (c), because *Mead* does not disclose what happens if a server becomes inoperable.

Regarding step (d), the Examiner states that when the servers of *Mead* are all available the method as claimed is clearly performed because step (d) only needs to occur when the messaging server is unavailable in step (b). However, *Mead* does not disclose what happens when its servers are **inoperable**. *Mead* does not disclose providing a message to a relay server when the messaging server is inoperable, re-routing the message from the relay server to a messaging server if the messaging server becomes operational and invoking another messaging server if the messaging server in step (c) does not become operational.

The Examiner supports his position that *Mead* anticipates claim 1 based on an overly broad interpretation of claim 1 (*see* Office Action, Dec. 31, 2007, pp. 26-28). The Examiner states that "if a reference discloses a method where a message is routed to a messaging server that is operational, then [claim 1] is anticipated" (*Id.* at 27). The Examiner's position blatantly ignores steps (b), (c), and (d) of claim 1. It is elementary that a reference cannot anticipate a claim without disclosing all of the claim's limitations. Here, steps (b), (c), and (d) occur if the messaging server of step (a) is inoperable such that it is unable to receive a message. Therefore, for a reference to anticipate claim 1, it must disclose that steps (b), (c), and (d) occur when a messaging server is inoperable. As discussed above, *Mead* has no such disclosure, and therefore does not anticipate claim 1.

For the reasons above, Applicant requests that the Board reverse the rejection of claim 1 as anticipated by *Mead*. Applicant also requests that the Board reverse the rejection of claims 3-5 and 7-8, which are dependent from claim 1, because claim 1 is allowable.

b. Claims 9, 11-13, and 15-19

As discussed above with respect to claim 1, *Mead* neither discloses any of its servers becoming inoperable nor the path a message would take if any of its servers became inoperable. *Mead* merely discloses sending a message from a home mail server to a vehicle server via an intermediate ground server. Therefore, *Mead* does not anticipate the limitations of claim 9.

The Examiner supports his rejection of claim 9 based on an overly broad interpretation of claim 9. Specifically, the Examiner states: "As a DNS server is capable of forwarding messages to any device that is connected to the network, a DNS server is operable to perform the functionality in this specific instance" (Office Action, Dec. 31, 2007, p. 28). A DNS

server is only operable to forward messages to a particular device at a particular time if the DNS server is programmed or otherwise directed to forward the messages. Thus, for a reference to anticipate claim 9 the reference must disclose a DNS server that is programmed or otherwise directed to forward messages to the devices specified in claim 9 upon the occurrence of the specific events in claim 9. Specifically, claim 9 requires "the DNS server operable to provide the message to the relay server when the messaging server is inoperable." *Mead* does not anticipate claim 9 because it does not disclose a DNS server that is operable (i.e. programmed or otherwise directed) to provide a message to a relay server when the messaging server is inoperable.

For these reasons and the reasons discussed above with respect to claim 1, Applicant requests that the Board reverse the rejection of claim 9 as anticipated by *Mead*. Applicant also requests that the Board reverse the rejection of claims 11-13 and 15-19, which are dependent from claim 9, because claim 9 is allowable.

6. Claim 18 is not indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the Office Action mailed on December 31, 2007, the Examiner rejected claim 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because claim 18 was dependent from claim 10, which had previously been cancelled. An Amendment After Final with an amendment to claim 18 was filed on March 28, 2008 concurrently with the Notice of Appeal. Claim 18 was amended to present rejected claim 18 in better form for consideration on appeal pursuant to 37 C.F.R. § 1.116(b)(2). Claim 18 as amended depends from claim 9, which is still pending. In an Advisory Action dated April 25, 2008, this claim amendment was entered by the Examiner for purposes of appeal. Applicant submits that claim

18 as amended is not indefinite under 35 U.S.C. § 112, and that this rejection should be reversed by the Board.

VIII. CLAIMS APPENDIX

See Claims Appendix (Pending Claims) attached hereto.

IX. EVIDENCE APPENDIX

See Evidence Appendix attached hereto.

X. RELATED PROCEEDINGS APPENDIX

See Related Proceedings Appendix attached hereto with the decision of the Board of Patent Appeals and Interferences in Appeal No. 2007-1044.

Respectfully submitted,

By: 

Mark C. Young, Reg. No. 48,670
STINSON MORRISON HECKER LLP
1201 Walnut Street, Suite 2900
Kansas City, MO 64106
Telephone: (816) 842-8600
Facsimile: (816) 691-3495

CLAIMS APPENDIX



1. A method for providing a messaging service on a computer network, the method comprising the steps of:
 - (a) routing a message to a messaging server;
 - (b) providing the message to a relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server;
 - (c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational; and
 - (d) invoking another messaging server if the messaging server in step (c) does not become operational.
2. (Cancelled)
3. The method of Claim 1 further comprising:
 - (e) routing the message to the other messaging server of step (d).
4. The method of Claim 3:
further comprising (f) storing the message; and
wherein step (e) comprises changing server information of the stored message.
5. The method of Claim 1 wherein step (c) comprises periodically attempting delivery of the message from the relay server to the messaging server.
6. (Cancelled)

7. The method of Claim 1 further comprising:

(d) sending the message to the messaging server in response to step (c).

8. The method of Claim 3 further comprising:

(f) sending the message to the other messaging server in response to step (e).

9. A computer network for providing a messaging service, the network comprising:

a messaging server;

a DNS server operable to route a message to the messaging server;

a relay server operably connected to the DNS server and the messaging server, the DNS server operable to provide the message to the relay server when the messaging server is inoperable such that the message is undeliverable to the messaging server;

wherein the relay server is operable to re-route the message from the relay server to the messaging server if the messaging server becomes operational; and

another messaging server, the other messaging server invoked by the relay server if the messaging server does not become operable such that the message is undeliverable to the messaging server in response to the re-routing.

10. (Cancelled)

11. The network of Claim 9 wherein the relay server is operable to route the message to the other messaging server.

12. The network of Claim 11 further comprising:

a storage device operably connected to the relay server and the other messaging server, the message being stored in the storage device; and

wherein the relay server is operable to change server information of the stored message to route the message to the other messaging server.
13. The network of Claim 9 wherein the relay server is operable to periodically attempt delivery of the message from the relay server to the messaging server.
14. (Cancelled)
15. The network of Claim 9 wherein the relay server is operable to send the message to the messaging server in response to the re-routing.
16. The network of Claim 11 wherein the relay server is operable to send the message to the other messaging server in response to routing the message to the other messaging server.
17. The network of Claim 9 wherein the messaging server and the relay server are within a first data center.

18. The network of Claim 9 wherein the messaging server and the other messaging server are in first and second data centers, the first data center remote from the second data center.

19. The network of Claim 9 wherein the relay server is operable to invoke a process to create another messaging server with a same name and IP address.

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EVIDENCE APPENDIX

EXHIBIT A

domain name system

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DEFINITION - The domain name system (DNS) is the way that Internet domain names are located and translated into Internet Protocol addresses. A domain name is a meaningful and easy-to-remember "handle" for an Internet address.

Because maintaining a central list of domain name/IP address correspondences would be impractical, the lists of domain names and IP addresses are distributed throughout the Internet in a hierarchy of authority. There is probably a DNS server within close geographic proximity to your access provider that maps the domain

names in your Internet requests or forwards them to other servers in the Internet.

LAST UPDATED: 16 Feb 2004

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RELATED PROCEEDINGS APPENDIX

1204

The opinion in support of the decision being entered
today is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY L. OEHRKE

Appeal 2007-1044
Application 09/594,070
Technology Center 2100

Decided: July 31, 2007

DOCKETED

Source: 083163-0150 JC
Docketed by and date: S-8-8-07
Stamped by and date: LMP-8-8-07
Indexed by date: _____

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT, and JAY P.
LUCAS, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-19, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to messaging in computer networks for guaranteed messaging service on an internet provider (IP) network (Specification 1). According to Appellant, instead of returning a message as

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undeliverable, the message is rerouted to a relay server (Specification 2) which attempts to re-send or re-route the message (*id.*).

Independent Claim 1 reads as follows:

1. A method for providing a messaging service on a computer network, the method comprising the steps of:
 - (a) routing a message to a messaging server;
 - (b) providing the message to a relay server when the message is undeliverable to the messaging server; and
 - (c) re-routing the message from the relay server to the messaging server when operational.

The prior art references relied upon by the Examiner in rejecting the claims on appeal are:

Nelson	US 5,974,122	Oct. 26, 1999
Doshi	US 6,130,875	Oct. 10, 2000 (filed Oct. 29, 1997)
McDowell	US 6,438,583 B1	Aug. 20, 2002 (filed Jun. 23, 1999)

The Examiner rejected claims 1-4, 7-12, and 15-19 under 35 U.S.C. § 103(a) as being unpatentable over McDowell and Nelson and claims 5, 6, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over McDowell, Nelson, and Doshi.

We reverse.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103. The issue turns on whether there is a legally sufficient justification for combining the disclosures of

McDowell and Nelson and if so, whether the combination teaches the claimed subject matter. Specifically, the issue is:

whether storing the undeliverable facsimile in the messaging platform of Nelson and attempting to deliver it later, when combined with the teachings of McDowell, is the same as providing a message to a relay server when the message is undeliverable and rerouting the message to the messaging server when operational, as recited in the claims.

FINDINGS OF FACT

The following findings of fact (FF) are believed to be supported by a preponderance of the evidence.

1. McDowell relates to a method and apparatus for re-routing of e-mail messages destined for a prior address to the new address of an intended recipient (Abstract).

2. Instead of ignoring an undeliverable message, McDowell re-routes the e-mail sent to an old Internet Service Provider (ISP) to a re-route server that sends the message to the new address on another ISP (col. 1, ll. 48-55). Alternatively, the old ISP may forward the message directly to the other ISP (col. 1, ll. 59-61).

3. As shown in Figures 1A-14B, the reroute server always re-routes the message to the new ISP without attempting to send it to the old ISP because the address on the old ISP is not operational anymore as the user is no longer a subscriber to the old ISP (col. 1, ll. 51-53). For example, Figure 1 shows that the message is sent to a re-route server which in turn sends it to the new ISP based on the forwarding information present in the old ISP (col. 7. ll. 11-33).

4. If the undeliverable message to the old ISP has a valid re-route request, the message is passed to the re-route server where the new address for the recipient is determined from stored information and used for forwarding the message to the recipient's new address (col. 8, ll. 1-13).

5. Nelson describes a facsimile system wherein the facsimile message is stored on a messaging platform only if the destination is unavailable at the first time and is transmitted a second time when the destination becomes available (Abstract; col. 1, l. 65 through col. 2, l. 7).

6. Nelson further shows in Figure 3 the facsimile routing through a communications network that includes originating Service Switching Point (SSP) 216 corresponding to the originating fax machine and destination SSP 208 corresponding to the destination fax machine 206 (col. 4, ll. 26-33). If the destination condition is "busy" or "no answer" at the first time, the originating SSP routes the telephone call and the facsimile message to a messaging platform 214 which stores the message and attempts transmitting at a later time (col. 4, ll. 50-65 and col. 6, ll. 6-26).

PRINCIPLES OF LAW

A claimed invention is unpatentable as obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *See* 35 U.S.C. § 103(a) (2002); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40, 82 USPQ2d 1385, 1395 (2007)). “One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397. Design incentives and market forces as well as implementing a predictable variation may also help the person of ordinary skill in the art to recognize the obviousness of claimed combinations of elements of prior art. *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396.

Alternatively, a holding of obviousness can be based on a showing that there was “an apparent reason to combine the known elements in the fashion claimed.” *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. In other words, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). However, this reasoning is not limited to the problem the patentee was trying to solve; “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397 (emphasis added).

Furthermore, a reference may be understood by the artisan as suggesting a solution to a problem that the reference does not discuss. *See KSR*, 137 S. Ct. at 1742, 82 USPQ2d at 1397 (“Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. “Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.” *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). *See also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

ANALYSIS

The rationale argued by the Examiner for combining the references is based on the common goal of ensuring the delivery of messages when the delivery to the destination fails (Answer 4 and 8). Appellant contends that the references are directed to different kinds of problems and do not share a common goal (Br. 10; Reply Br. 6). We agree with Appellant. While McDowell attempts to re-route e-mail messages to a recipient who is no longer a subscriber of an old ISP (FF 1 & 2) and Nelson describes resending of facsimile messages to a number which was busy the first time (FF 5), the problems the two references solve and the mechanism by which the messages are re-routed are not the same.

We also agree with Appellant (Reply Br. 6-7) that McDowell's re-routing the e-mail message that was sent to the correct address in the correct ISP but to a recipient who is no longer a subscriber differs from Nelson's re-routing a facsimile message to a number that is busy. McDowell merely forwards the e-mail message to a re-route server only if the new address of the subscriber can be identified, either based on the forwarding information (FF 3) or if the re-route server has the information in the storage (FF 4). Nelson on the other hand, sends the facsimile message to the correct number or subscriber and if the number is busy or does not answer, sends the message to the message platform to be temporarily stored (FF 5).

Therefore, the specific problem encountered by each of the references is caused by different failures and have different solutions. McDowell, attempts to re-route the message to the ISP where the recipient is currently subscribed to whereas Nelson stores the message for later delivery to the same number. In that regard, the only predictable result that may be achieved by storing the e-mail in McDowell and resending it to the same old ISP is that the message will still be undeliverable since the recipient no longer subscribes to the old ISP.

Additionally, the Examiner's explanation (Answer 9) as to why the facsimile service network of Nelson may include servers notwithstanding, the differences between the cause of messages being undeliverable and the mechanism for re-routing the messages of McDowell and Nelson would not have prompted a person of ordinary skill in the relevant field to combine the elements in the way the instant claims require. Thus, we find that Examiner's rejection rests on less than a preponderance of evidence and

thus, fails to provide sufficient reasons for finding claims 1-4, 7-12, and 15-19 unpatentable for obviousness under 35 U.S.C. § 103(a) over McDowell and Nelson.

With respect to the rejection of claims 5, 6, 13, and 14 over the combination of McDowell and Nelson with Doshi, we note that the Examiner has not pointed to any teachings in Doshi that would have overcome the deficiency of McDowell and Nelson combination as discussed above. Thus, we do not sustain the 35 U.S.C. § 103 rejection of claims 5, 6, 13, and 14 as being unpatentable over McDowell, Nelson, and Doshi.

DECISION

The decision of the Examiner rejecting claims 1-19 under 35 U.S.C. § 103 is reversed.

Appeal 2007-1044
Application 09/594,070

REVERSED

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